

Serial No. 10/726,461
Attorney Docket No. 24170759.2

REMARKS/ARGUMENTS

The Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and the following remarks/arguments. Claims 1-50 were originally filed with the present Application. In response to a Restriction Requirement by the Examiner, the Applicants have elected to prosecute claims 1-25 in the present Application, and claims 26-50 are withdrawn from consideration at this time. By this Amendment, claims 1, 12-14, 19, and 22-23 are amended. No claims have been added or canceled at this time. Accordingly, claims 1-25 are currently pending in the present Application, and no new matter has been added.

I. RESTRICTION REQUIREMENT

The Examiner has issued a restriction requirement in the present application asserting that claims 1-25 (Group I), claims 26-41 (Group II), and claims 42-50 (Group III) are directed to respective separate inventions. In a telephone conversation with the Examiner, the Applicants provisionally elected to prosecute Group I at this time. By the present Amendment, the Applicants hereby formally elect to prosecute Group I (claims 1-25), without traverse, and without prejudice to prosecuting the withdrawn claims at a later time, in accordance with the provisional election.

II. OBJECTIONS

The Examiner has objected to claim 19 as having an informality, specifically a spelling error. In response, the Applicants have amended claim 19 in accordance with the Examiner's suggestion, and the Applicants thank the Examiner for the diligence used in the examination of the pending claims.

III. REJECTION UNDER 35 U.S.C. §112

The Examiner has rejected claims 12-13 and 22-23 under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point put and particularly claim

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the subject matter which the Applicants regard as the invention. In response, while the Applicants may not necessarily agree with the Examiner's rejection, the Applicants have amended claims 12-13 and 22-23 in accordance with the Examiner's suggestions. Accordingly, the Applicants respectfully request the §112 rejection be withdrawn.

IV. REJECTIONS UNDER 35 U.S.C. §102

The Examiner rejected claims 1-4, 7-10, 14-15, 20, and 25 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 4,668,325 to Katz. The Examiner also rejected claims 12-13 and 22-23 also under 35 U.S.C. §102(b) as allegedly anticipated by Katz. The Applicants have amended independent claims 1 and 14 to recite that the first and second layers of the fiber material are both nonwoven material layers. Katz discloses the use of a primary woven layer coupled to a secondary layer that may be woven or nonwoven. (Col. 4, lines 38-59). As such, Katz does not disclose each element of amended independent claims 1 and 14. In addition, the remaining claims rejected as anticipated by Katz (claims 2-4, 7-10, 12-15, 20, 22-23 and 25) are also patentably distinct since they each depend from either amended claim 1 or 14. Accordingly, the Applicants respectfully request that the Examiner withdraw the §102(b) rejection with respect to claims 1-4, 7-10, 12-15, 20, 22-23 and 25.

V. REJECTIONS UNDER 35 U.S.C. §103

The Examiner has rejected dependent claims 5-6, 11-13, 16-17, and 21-24 under 35 U.S.C. §103(a) as allegedly obvious in view of Katz. As discussed above, Katz does not disclose or teach all of the elements recited in independent claims 1 and 14. Therefore, the Applicants respectfully assert that these claims are not obvious in view of Katz, since these dependent claims respectively depend from amended independent claims 1 and 14.

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In addition, Katz teaches away from providing first and second layers that are both nonwoven, as recited in amended claims 1 and 14. Specifically, Katz is directed to providing a needlepoint fabric, and thus explicitly teaches the use of a woven material for the primary layer. There is no suggestion for changing the primary layer in Katz to a nonwoven material because it would frustrate a primary use or purpose of Katz, which is to provide a needlepoint material. As discussed in Katz, the primary layer is woven so as to provide specific "holes or apertures" in between the threads that comprise the primary layer. (Col. 6, lines 10-27; FIG. 4). In fact, how these apertures are created and maintained is a distinguishing factor of Katz over the described prior art fabrics. (Col. 5, line 61, to col. 6, line 9; FIGS 1-3). When a fabric is used for needlepoint, the needle held by the person penetrates the fabric at specific locations, which are the apertures taught by Katz. In fact, needlepoint fabrics are manufactured and sold in specific "gauges" (e.g., col. 4, line 20), which define the size of the apertures in the fabric defined by the woven layer. To this end, Katz uses the sheer secondary layer to help hold the alignment and spacing of the apertures. (Col. 5, lines 13-29).

Furthermore, the Examiner states that properties for the disclosed material recited in rejected claims are not explicitly taught by Katz, but that such claimed properties are still obvious in view of Katz. However, the Applicants respectfully request that, since the Examiner admits Katz does not explicitly teach these limitations, the Examiner point to a specific teaching or basis to support the rationale for rejecting these claims as obvious. Although the Applicants acknowledge that the rationale for supporting a rejection under §103 may be reasoned from common knowledge in the art or from scientific principles, the Applicants respectfully assert that the burden of initially establishing a *prima facie* case of obviousness still rests with the Examiner. As a result, the Examiner offers no scientific basis or rationale to support the

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assertion that the claimed properties would automatically result from use of the materials and structures disclosed in Katz, and a mere statement to that effect is not sufficient. To accept such an assertion is to say that the claimed properties are necessarily present in Katz's materials and structures when no proof to that effect has been provided or cited. M.P.E.P. 2144.02-2144.03.


For at least these reasons, Katz does not teach or suggest all of the elements of amended independent claims 1 and 14, from which the rejected dependent claims respectively depend, and a *prima facie* case of obviousness of all of the rejected claims has not been presented. Thus, the Applicants respectfully request that the Examiner withdraw the §103(a) rejections.

VI. CONCLUSION

The Applicants respectfully submit that pending claims 1-25 are in condition for allowance, and request a Notice of Allowability for the pending claims. The Examiner is invited to contact the undersigned Attorney of Record if such would expedite the prosecution of the present Application. The Applicants respectfully request a one month Extension of Time in which to file the present Amendment, and have included the required payment herein. However, if it is determined that additional fees are due, or an overcharge or overpayment has occurred, please charge or credit Deposit Account No. 13-0480, referencing the Attorney Docket Number 24170759.2.

Respectfully submitted,

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